The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENRY H. JENKINS

Appeal No. 2003-1386
Application No. 09/580,412

ON BRIEF

Before WARREN, WALTZ, and MOORE, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

Upon a review of the record in this application, we determine that this appeal is not ripe for decision at this time. Accordingly, pursuant to the provisions of 37 CFR § 1.196(a), we *remand* this application to the jurisdiction of the examiner to correct and clarify the record consistent with our remarks below.

In the final Office action dated Mar. 8, 2002, Paper No. 7, claims 1-25 were pending in this application and the examiner set forth three rejections as follows: (1) claims 1 and 4-6 were rejected under 35 U.S.C. § 103(a) over Brayton in view of Dewes;

(2) claims 2-3 were rejected under 35 U.S.C. § 103(a) over Brayton in view of Johnson; and (3) claims 7-25 were rejected under 35 U.S.C. § 103(a) over Johnson.[1] Appellant submitted a timely Notice of Appeal and a Brief (dated Apr. 19, 2002, Paper No. 8, and May 10, 2002, Paper No. 9, respectively).

In response to appellant's Brief (Paper No. 9), the examiner notified appellant that this Brief was defective since appellant argued that the claims do not stand or fall together but failed to provide separate reasoning to support this argument as required by 37 CFR § 1.192(c)(7)(see Paper No. 10 dated July 25, 2002). In response to the examiner's notification, appellant submitted an "Amended New Appeal Brief" dated Aug. 3, 2002, Paper No. 11 (hereafter the "Brief").

In the examiner's Answer dated Oct. 23, 2002, Paper No. 12 (hereafter the "Answer"), the examiner withdrew the rejections of claims 1-6 (Answer, page 2, ¶(6); page 4, ¶(11)). However, on page 2, ¶(7), of the Answer, the examiner stated that appellant's Brief "includes a statement that claims 2-3 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8)." This statement by the examiner is irrelevant since the rejection of claims 2-3 has been withdrawn (Answer, page 2,

[1]U.S. Patent No. 5,676,032, issued Oct. 14, 1997.

¶(6)). Additionally, this statement is incomplete since the examiner has not recognized the statement on page 6 of the Brief, namely that with respect to the remaining rejection on appeal, "[c]laims 7, 9, 11, 14, 16, 18, 20, 22 and 24 stand or fall on their own." The examiner has also not commented on the reasons set forth by appellant supporting the separate patentability of these claims (Brief, pages 10-11). Finally, the examiner has not separately considered all of these claims in the Answer (see the Answer, pages 3-4).

On page 3 of the Answer, the examiner states the sole ground of rejection in this appeal. However, claims 18, 19, 24 and 25 are missing from this statement of the rejection, even though the examiner has not indicated that these claims are allowable. Furthermore, the examiner addresses these claims in the body of the rejection (Answer, page 4, first paragraph).

On page 3 of the Answer, the examiner implicitly states that claims 14-17 and 20-23 are anticipated by Johnson but "[t]his rejection is not considered to be a new issue, since anticipation is within the confines of obviousness."

In the paragraph bridging pages 5-6 of the Answer, the examiner addresses the interpretation of claims 18, 19, 24 and 25 (which claims were not included in the statement of the

rejection), stating that "if these claims are interpreted to mean that the terminal ends of the dies are oblique to the cutting edge, then a different rejection would need to be applied."

As noted above, the examiner has withdrawn all rejections pertaining to claims 1-6 (Answer, pages 2 and 4). However, claims 7-25 remain rejected in view of Johnson (Answer, page 3). In view of the similarity of the steel rule die recited in claim 1 and that recited in claim 7, a statement of reasons for allowance would be appropriate in this situation. *See MPEP* § 1302.14, 8th ed., Aug. 2001.

We *remand* this application to the jurisdiction of the examiner to correct and clarify the above noted record as follows:

(1) the examiner should address the appellant's grouping of claims and determine if the reasons presented for separate patentability are reasonably specific and substantive; if so, the examiner should separately address each argument presented by appellant in accordance with 37 CFR § 1.192(c)(7)(8)(2000);[2]

[2]*See In re McDaniel,* 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002); *and Ex parte Schier,* 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991).

(2) the examiner should include the appropriate claims in the statement of the rejection, indicating the status of all pending claims including claims 18, 19, 24 and 25;

(3) if the examiner determines that some of the pending claims are anticipated by the Johnson reference, a new ground of rejection of the claims should be explicitly entered in the record;

(4) the examiner should explicitly state how the claim language is interpreted, comparing the scope of the claimed subject matter to the applied prior art, and set forth any conclusions of law, without resort to speculation about "different rejections;" and

(5) a statement of reasons for allowance should be entered into the record, distinguishing objected claim 1 from claim 7 which remains rejected.

Pursuant to 37 CFR § 1.193(b)(1), we specifically authorize the examiner to address the above noted corrections and clarifications in a supplemental examiner's Answer. However, if any new ground of rejection is made, prosecution of this application must be reopened and a supplemental examiner's Answer is not authorized.

This application, by virtue of its "special" status, requires an immediate action, *MPEP* § 708.01, (D). It is important that the Board be promptly informed of any action affecting the appeal in this application.

REMANDED

Charles A. Warren)
Administrative Patent Judge)
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Thomas A. Waltz) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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Application No. 09/580,412

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